

Notice of Allowability

Application No.

10/521,508

Examiner

Yong Chu

Applicant(s)

HAN ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/25/2006.
2. ☒ The allowed claim(s) is/are 1-6 and 12.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

Claims 7-11 have been canceled by the Supplemental Amendment filed on 5 May 2006. Claims 1, 5, and 6 have been amended by the Supplemental Amendments filed on 5 May 2006, and 25 May 2006. Therefore, Claims 1-6, and 12 are pending in this application.

Response to Amendment

The Supplementary Amendments by Applicants' representative Attorney Sylvia A. Ayler dated on 5 May 2006, and 26 May 2006, have been entered.

Examiner's amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 2, line 1, delete "(Amended)" after "1" and insert --(Previously Presented)--.

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 2, line 5, delete "O or" after "X is".

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 2, line 7, insert --or-- after "1) CH₂CH₂".

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 2, line 8, delete ", or" after "2) CHCH," and insert --;--.

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 2, line 18, insert --,-- after "4) CH₂".

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 2, line 19, insert --or-- after "CH=CH,".

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 2, line 20, delete ", or" after "6) C≡C" and insert --;--.

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 3, line 30, insert --or-- after "O-C₅₋₁₀heterocycloalkyl,".

In claim 1 of the Supplementary Amendment dated on 26 May 2006, page 3, line 31, insert --,-- after "O-C₃₋₁₀cycloalkyl".

In claim 5 of the Supplementary Amendment dated on 26 May 2006, page 5, line 1, delete "(Amended)" after "5" and insert --(Previously Presented)--.

In claim 5 of the Supplementary Amendment dated on 26 May 2006, page 5, line 4, insert --or-- after " 2) CH=CH,".

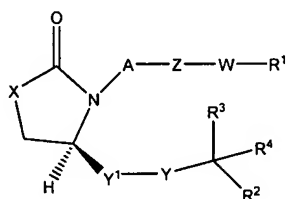
In claim 5 of the Supplementary Amendment dated on 26 May 2006, page 5, line 5, delete ", " after "3) C≡C," and insert --;--.

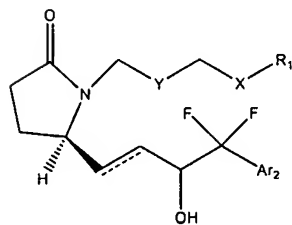
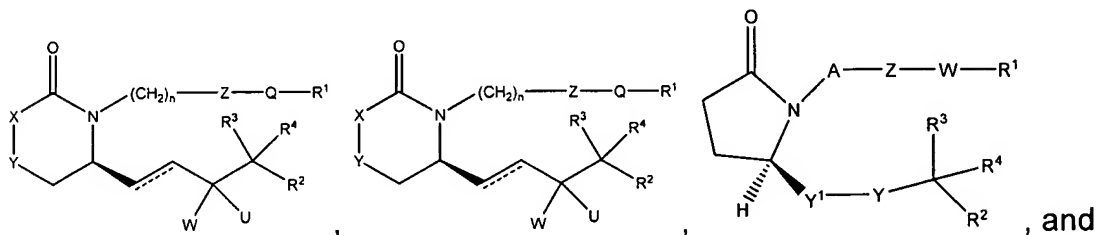
In claim 6 of the Supplementary Amendment dated on 26 May 2006, page 6, line 1, delete "(Original)" after "6" and insert --(Amended) --.

In claim 6 of the Supplementary Amendment dated on 26 May 2006, page 10, line 18, insert --and-- after "yl}propyl)thio]propanic acid,".

Reasons for Allowance

The present invention is directed to a compound of oxazolidin-2-one and

thiazolidin-2-one derivatives , wherein X is O, or S and a pharmaceutical composition for use as EP4 receptor agonist in the treatment of glaucoma. The closest references of record are U.S. Patent 7,053,085; U.S. Patent Application 11/146,992; 10/528,419; and 10/511,736, which disclose compounds or pharmaceutical compositions for treating glaucoma with the structures of



respectively. These compounds are related but patentably distinct

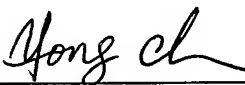
to the compounds disclosed in the instant application. These four references have the same assignee as the instant application but have no (Provisional) Obvious Double Patenting found. Therefore, claims 1-6 and 12 are allowed.

Telephone Inquiry

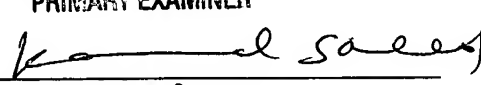
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER

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